

### **REMARKS**

Claims 7-8, 13, 17, 22-23, 28, and 32 are currently pending, claims 9-12, 14-16, 18-21, 24-27, 29-31 and 33-36 have been cancelled, and claims 37-49 have been withdrawn.

Claims 7 and 22 were amended to affirmatively include a lubricant in claimed subject matter and claims 13, 16, and 29-30 were amended to delete reference to the term lubricant as these claims are dependent from claims 7 and 22. Support for the amendments to claims 7 and 22 can be found throughout the specification at, for example, page 4, lines 14.

It is submitted the present amendments introduce no new matter.

### **Objection**

Claims 10 and 25 were objected to for containing the following "informalities:" in the claims "manitol" is a misspelling. (Paper No. 7 at 2.) As noted above, claims 10 and 25 have been cancelled and, it is submitted, the objection is rendered moot and should be withdrawn.

### **Written Description Rejection**

Claims 7-36 were rejected under 35 USC §112, first paragraph, as containing subject matter that was not described in the specification in such a way to convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. (Paper No. 7 at 2.) In making the rejection, the Examiner contended that "[t]he specification fails to support a tablet containing only lactase and microcrystalline cellulose as in claim 7." (Paper No. 7 at 3.)

Claim 7 has been amended to affirmatively require a lubricant. It is believed that at page 4, lines 1-14 of the instant specification, a tablet is described as containing a lubricant. Accordingly, it is believed that claim 7 and the claims depending therefrom are fully supported by the specification and this rejection should be withdrawn.

Claim 22 has been amended to affirmatively require a lubricant. It is believed that at page 4, lines 1-14 of the instant specification, a particular composition, e.g., a tablet, is described as containing a lubricant. Accordingly, it is believed that claim 25 and the claims depending therefrom are fully supported by the specification and this rejection should be withdrawn.

In making the rejection of claims 8 and 23, the Examiner asserted that the “specification fails to support any mixture of the members of the Markush group.” (Paper No. 7 at 3.) The Examiner contended that while the members of the group are recited in the specification, forming a mixture of any of the members is not disclosed. (*Id.*)

While not agreed with and fully reserving the right to re-introduce the full subject matter of claims 8 and 23 in a subsequent paper, the term “and mixtures thereof” has been cancelled. Therefore, it is submitted, the rejection is rendered moot and should be withdrawn.

In making the rejection of claims 9-12, 14, 16, 18-21, 24-27, 29-31, and 33-36, the Examiner asserted that the specification fails to recite or contain adequate support for the combination of components in these claims. (Paper No. 7 at 3.) The Examiner contended that the specification failed to recite or support components in combinations as claims. (*Id.*)

While not agreed with and fully reserving the right to re-introduce claims 9-12, 14, 16, 18-21, 23-27, 29-31, and 33-36 in a subsequent paper, such claims have been cancelled and, it is submitted, the rejection is rendered moot and should be withdrawn.

**Obviousness Rejection**

Claims 7, 8, 13, 15, 17, 22, 28, and 32 were rejected under 35 USC §103(a) as being unpatentable over Eisenhardt, US Pat. No. 6,410,018, in view of Schwartz (US Pat. No. 4,034,035) and Bowman (US Pat. No. 3,954,979), and, if necessary, in further view of Cayle (US Pat. No. 3,718,739) (Paper No. 7 at 4.)

For the reasons set forth below the rejection, respectfully is traversed.

Eisenhardt has an effective filing date of September 28, 1993. McNeil-PPC, Inc. is the assignee of Eisenhardt.

The captioned application has an effective filing date of June 25, 1995. McNeil-PPC, Inc. is the assignee of the captioned application.

It is believed that Eisenhardt is only available as prior art only under 35 USC § 102 (e), (f) or (g).

It is submitted that Eisenhardt and the captioned application were, at the time the instant invention was made, owned by or subject to an obligation of assignment to the

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same person. 1241 OG 96 (Dec. 26, 2000). Because the captioned application was filed on or after November 29, 1999, the captioned application qualifies for the benefit of the §103(c)/102(e) exclusion of common assignee-type prior art. 1233 OG 54 (Apr. 11, 2000). Therefore, Eisenhardt is not available as reference to reject the captioned application for obviousness. For this reason, the rejection is improper and should be withdrawn.

Claims 9-12, 14, 16, 18-21, 23-27, 29-31, and 33-36 were rejected under 35 USC §103(a) as being unpatentable over the references as applied to claims 7, 8, 13, 15, 17, 22, 28, and 32 above, and further in view of Shen (US Pat. No. 5,637,561) (Paper No. 7 at 5.)

For the reasons set forth below the rejection, respectfully is traversed.

Claims 9-12, 14, 16, 18-21, 24-27, 29-31, and 33-36 have been cancelled, therefore, it is submitted, this rejection is moot and should be withdrawn as to those claims.

As to the remaining rejection to claim 23, Eisenhardt has an effective filing date of September 28, 1993. McNeil-PPC, Inc. is the assignee of Eisenhardt.

The captioned application has an effective filing date of June 25, 1995. McNeil-PPC, Inc. is the assignee of the captioned application.

It is believed that Eisenhardt is only available as prior art only under 35 USC § 102 (e), (f) or (g).

It is submitted that Eisenhardt and the captioned application were, at the time the instant invention was made, owned by or subject to an obligation of assignment to the same person. 1241 OG 96 (Dec. 26, 2000). Because the captioned application was filed on or after November 29, 1999, the captioned application qualifies for the benefit of the §103(c)/102(e) exclusion of common assignee-type prior art. 1233 OG 54 (Apr. 11, 2000). Therefore, Eisenhardt is not available as reference to reject the captioned application for obviousness. For this reason, the rejection to claim 23 is improper and should be withdrawn.

#### **Double Patenting**

Claims 7, 8, 13, 15, 17, 22, 28, and 32 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-11 of

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US Pat. No. 6,365,208 or claims 1-8 of US Pat. No. 6,057,139 in view of Schwartz and Bowman, and if necessary, in further view of Cayle. (Paper No. 7 at 7.)

In making the rejection, the Examiner asserted that the claims of the patents require a formulation containing lactase and microcrystalline cellulose and the second bases of rejection was based on the Examiner's assertion that it would have been obvious to provide this formulation in tablet form for reasons previously set forth regarding application of Schwartz, Bowman and Cayle.

Upon notification by the Examiner that claims 7, 8, 13, 15, 17, 22, 28, and 32 are allowable but for this rejection, the option of filing a Terminal Disclaimer will be addressed.

Claims 9-12, 14, 16, 18-21, 23-27, 29-31, and 33-36 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims of the patents in view of Schwartz and Bowman, and if necessary, in further view of Cayle and in further view of Shen for the reason set forth above when applying Shen. (Paper No. 7 at 7.)

At the outset, it is submitted that this rejection only applies to claim 23 as the other claims have been cancelled and render the rejection moot.

As to the rejection of claim 23, the record is unclear as to what "claims of the patents" the Examiner intends to rely on in making the rejection. For this reason, the rejection is improper and should be withdrawn.

Nonetheless, it is presumed that the Examiner relied on claims 1-11 of US Pat. No. 6,365,208 or claims 1-8 of US Pat. No. 6,057,139. The Examiner is asked to confirm this in the next paper issued in the captioned application.

Upon notification by the Examiner that claim 23 is allowable but for this rejection, the option of filing a Terminal Disclaimer will be addressed.

Accordingly, for the reasons set forth above, entry of the amendments, withdrawal of the rejections and objections, and allowance of the claims is respectfully requested.


Finally, the Examiner is invited to call the applicants' undersigned representative if any further action will expedite the prosecution of the application or if the Examiner has any suggestions or questions concerning the application or the present Response. In fact, if the claims of the application are not believed to be in full condition for allowance,

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for any reason, the applicants respectfully request the constructive assistance and suggestions of the Examiner in drafting one or more acceptable claims pursuant to MPEP § 707.07(j) or in making constructive suggestions pursuant to MPEP § 706.03 so that the application can be placed in allowable condition as soon as possible and without the need for further proceedings.

Respectfully submitted,

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